

REMARKS

Reconsideration and allowance are respectfully requested.

Applicants acknowledge with appreciation the possibility of rejoinder upon indication of allowable subject matter.

The amended claims find basis in the specification. Amended claim 1 includes the "wherein" clause of original claim 4. Deleting "characterized by" in claim 1 and in claim 9 does not narrow claim scope and simply reflects an edit to improve colloquial English. Amended claim 2 now corresponds to a combination of original claim 1 and claim 5. Claim 3 remains. Amended claim 4 now recites the "wherein" clause of original claim 2. Claim 5 has been canceled. Claims 6 and 7 are amended in dependency. New claim 17 correlates to original claim 2 and new claim 18 depends from new claim 17.

Please withdraw the objections based on 37 C.F.R. §1.75(c).

The rejection of claims 1 and 3 under 35 U.S.C. §102(b) over Held (USP 4,988,478), Kaufman (USP 5,407,516) or Schwarz (USP 4,670,080); claim 1 and 3 under 35 U.S.C. §102(b) over Sjolin (USP 6,375,777) plus PCT 99/12736; claims 1 and 3 under 35 U.S.C. §102(b) or 103 over Held (USP 5,141,583); and the rejection of claim 2 under §103(a) over Sjolin, Held '583 or Held '528, in view of Verboom (USP 3,871,290) and in view of Stocker (USP 2,269,884), Rautakorpi (USP 6,536,704) or Crabtree (USP 2,461,109) are traversed.

The Examiner "bears the initial burden, on review of the prior art . . . , of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Section 102(b) entitles a person to a patent unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United

States." 35 U.S.C. § 102(b). Anticipation under § 102 can *only* arise when a prior art reference discloses each and every claim limitation either expressly or inherently. Any allegation of inherency must be supported by facts demonstrating the purported inherent matter was necessarily, inevitable, an always the outcome because probability, possibility and the like do not satisfy the heavy evidentiary burden required for anticipation.

A rejection cannot be predicated on the mere identification of individual components of claimed limitations. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "[I]t is incumbent upon the examiner to identify some suggestion to combine the references or make the modification." Ex parte Askman, Appeal No. 96-1548 (June 10, 1999) at page 5, quoting In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

The problem addressed by the present method and the manner of its being addressed are neither disclosed nor would they have been suggested to a person of ordinary skill in the art by the Rolle et al. reference. "A *prima facie* case of obviousness can be rebutted if the applicant ... can show `that the art in any material respect taught away' from the claimed invention." In re Geisler, 116 F.3d 1465, 1469 (Fed. Cir. 1997) (quoting In re Malagri, 499 F.2d 1297, 1303 (CCPA 1974)). A reference teaches away when a person of ordinary skill, upon reading the reference, would have been led in a direction divergent from the path that was taken by Applicants.

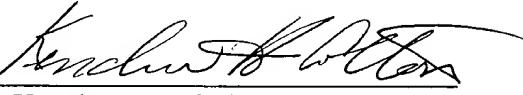
It is not seen where, for instance, the various items of asserted prior art disclose or would have suggested an apparatus for manufacturing a resin-impregnated cured sheet, such as claim 1 or 2. Additionally, the references, including Held '583 or Held '528, do not explicitly disclose one of the drums is a drive roll, nor would the references have suggested this.

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Applicants acknowledge the Examiner's indication that all claims may be considered as rejoinder. Applicants respectfully solicit rejoinder followed by allowability.

Respectfully submitted,

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